

REMARKS

In the Office Action, the Examiner rejected claims 1-4 and 10-12 under 35 U.S.C. § 103(a) as being unpatentable over Tanaka (U.S. Patent No. 6,906,374) in view of Matsuoka et al. (U.S. Patent No. 6,809,364, hereinafter “Matsuoka”); and rejected claims 6-9 under 35 U.S.C. § 103(a) as being unpatentable over Tanaka in view of Matsuoka and further in view of Nguyen et al. (U.S. Publication No. 2004/0092095, hereinafter “Nguyen”). The Examiner indicated that claims 5, 13, and 14 are drawn to allowable subject matter, and would be allowed if rewritten in independent form. Applicant thanks the Examiner for the indication of allowable material, but respectfully traverses the rejections.

Applicant respectfully traverses the rejection of claims 1-4 and 10-12 under 35 U.S.C. § 103(a) over Tanaka in view of Matsuoka. To establish a *prima facie* case of obviousness, three basic criteria must be satisfied. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine references. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all of the claim elements. See M.P.E.P. § 2143. Moreover, the requisite teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant’s disclosure. See *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). See M.P.E.P. § 706.02(j).

Claim 1 recites a “guard ring . . . provided such that said guard ring is electrically insulated from said first wiring, said second wiring, and said MIM capacitor,” (emphasis

added). Applicant respectfully submits that neither Tanaka nor Matsuoka teach or suggest at least this element recited in claim 1.

At page 2 of the Office Action, the Examiner contends that in Fig. 34 Tanaka discloses a “guard ring 54 [being] electrically insulated from the wirings and the MIM capacitor.” Applicant respectfully disagrees. Tanaka teaches that element 54 is a capacitor lower electrode. Col. 11, lines 31-34. Thus, element 54 is an integral part of an MIM capacitor. Accordingly, element 54 taught by Tanaka cannot constitute a “guard ring . . . electrically insulated from . . . said MIM capacitor,” as recited in claim 1.

The Examiner apparently concedes that Matsuoka fails to teach or suggest the claimed “guard ring,” and relies on the Matsuoka only to teach a second wiring. Office Action at page 3. Accordingly, the Examiner’s proposed combination of Tanaka and Matsuoka also fails to teach at least the claimed electrically insulated “guard ring,” recited in claim 1. Since the cited references, taken alone or in combination, fail to teach or suggest each element of claim 1, a *prima facie* case of obviousness is not established based on the applied references.

Claim 1 is allowable over Tanaka and Matsuoka for at least the above discussed reason. Claims 2-4 and 10-14 depend from claim 1, and are thus also allowable at least due to their dependence. Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claims 1-4 and 10-12 under 35 U.S.C. § 103(a).

Applicant respectfully traverses the rejection of claims 6-9 under 35 U.S.C. § 103(a) over Tanaka in view of Matsuoka and Nguyen. Claims 6-9 depend from claim 1 and thus incorporate each and every element recited in claim 1. As set forth above,

Tanaka and Matsuoka, taken alone or in combination, fail to teach at least the claimed “guard ring,” recited in claim 1 and required by claims 6-9. Nguyen is drawn to a “pre-liner and liner,” but also fails to teach the claimed “guard ring.” Col. 2, paragraph [0002]. Accordingly, claims 6-9 which depend from claim 1, are allowable over Tanaka, Matsuoka, and Nguyen, as none of the applied references, either alone or in combination, teach or suggest each and every element recited in claim 1. For at least this reason, Tanaka, Matsuoka, and Nguyen fail to establish a *prima facie* case of obviousness. Applicant respectfully requests the Examiner withdraw the rejection of claims 6-9 under 35 U.S.C. § 103(a).

In view of the foregoing remarks, Applicant submits that this claimed invention is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicant therefore requests the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: October 21, 2005

By:


Richard V. Burgujian
Reg. No. 31,744